

## **REMARKS/ARGUMENT**

### **I. General Remarks.**

Claims 1-28 and 30-39 are pending in the present application. Claims 29 and 40-122 were cancelled in a prior response. Claims 1-28 and 30-39 are currently rejected. Claims 1, 6-8, 13, 14, 25, 30, 32-34, and 39 have been amended herein. Claims 123-191 have been added herein.

Applicants respectfully request that the above amendments be entered, and further request reconsideration in light of the amendments and remarks contained herein. All the above amendments are supported by the application as filed, and are made in a good faith effort to advance the prosecution on the merits of this case. Applicants thank the Examiner for his careful consideration of this application, as well as all the references previously submitted with this application.

### **II. Remarks Regarding Double Patenting Rejection.**

The Examiner has rejected claims 1-39 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,796,378 B2 (hereinafter "*Reddy*"). Applicants previously filed a timely Terminal Disclaimer, with the appropriate fee, along with a prior Response, to overcome this rejection. In the Office Action dated April 27, 2005, the Examiner indicated that this Terminal Disclaimer was being held in abeyance, pending evaluation by PTO personnel of the propriety of the Examiner's rejection. In the Response to this Office Action, Applicants requested withdrawal of the previously filed Terminal Disclaimer. In the Office Action dated November 9, 2005, the Examiner failed to address this issue, despite Applicants' request for withdrawal while the Terminal Disclaimer was being held in abeyance. The Examiner then requested in the Office Action dated February 16, 2006 that the Applicants must petition to withdraw the terminal disclaimer because it had already been approved. Applicants submitted a Petition to withdraw the Terminal Disclaimer, however this Petition was dismissed. *See* Courtesy Copy of the Decision on the Petition to Withdraw the Terminal Disclaimer. In the Office Action dated December 5, 2006, the Examiner stated as follows:

The applicants have petitioned to withdraw the previously filed and approved Terminal Disclaimer. The applicants will soon be receiving the decision of the petition in an official communication indicating that the petition is approved and Terminal disclaimer

thus withdrawn. Nevertheless, this ODP rejection remains as stated above.

(Office Action at 3.) Applicants respectfully submit that the official communication received by the Applicants indicates that the Petition to withdraw the Terminal Disclaimer was dismissed. (Applicants have submitted with this response a courtesy copy of this decision for the Examiner's convenience.) Therefore, Applicants respectfully assert that the Terminal Disclaimer is still in effect, and thus respectfully request the withdrawal of the double patenting rejection.

### **III. Remarks Regarding Objection to the Specification.**

The Examiner has objected to the specification under 35 U.S.C. § 112, 1st Paragraph as failing to define the term "activate" (*i.e.* the cement composition) or an "activator." (Office Action at 3-4.) Furthermore, the Examiner states "[t]he applicants cannot hold hostage their own definition of activator (or accelerator) because 'activator' is not a commonly accepted term in the art for what they mean for their disclosure (ie accelerator) [*sic*]." (Office Action at 9). Applicants disagree. Applicants submit that the "activators," as described in the present specification and claims, are substantially similar to what are generally referred to in the art as "accelerators." However, Applicants respectfully assert that one of ordinary skill in the art would recognize that the term "accelerator" is generally used to refer to a particular composition that may be added to a cement composition not comprising a set retarder, while the term "activator" is generally used to refer to the same composition when it is added to a cement composition comprising a set retarder. Thus, Applicants respectfully submit that the terms used in Applicants specification are consistent with those terms commonly accepted in the art and that this disclosure is sufficient to meet the requirements of 35 U.S.C. § 112. Accordingly, Applicants respectfully request withdrawal of this objection.

### **IV. Remarks Regarding Rejections of Certain Claims Under 35 U.S.C. § 112, 2nd Paragraph.**

#### **A. Rejection of Claims 1-39 Pertaining to Activation of the Cement Composition.**

The Examiner has rejected the present claims as indefinite because "it is not clear what applicants mean by activating or use of an activator." The Examiner also states:

Further, do applicants mean an "accelerator" by the use of the term "activator". Please indicate in the next response if these two terms

have the same meaning. If applicants hold that they are the same, then this rejection will be withdrawn.

(Office Action at 4.) As stated in Section III above, the activators, as described in the present specification and claims, are substantially similar to what are generally referred to in the art as “accelerators.” However, Applicants again submit that one of ordinary skill in the art would recognize that the term “accelerator” is generally used to refer to a particular composition that is added to a cement composition not comprising a set retarder, while the term “activator” is generally used to refer to the same composition when it is added to a cement composition comprising a set retarder. Thus, Applicants respectfully submit that this disclosure is sufficient to meet the requirements of 35 U.S.C. § 112 and accordingly, request withdrawal of this rejection.

**B. Rejection of Claims 14 and 25 Pertaining to the Term “Chosen.”**

The Examiner has rejected claims 14 and 25 as indefinite for use of the term “chosen.” The Examiner states that “Applicants may consider simply deleting the terms ‘in a chosen thickening time’ in claim 14 and ‘for a chosen period of time’ to resolve this issue. The scope of the claim will be unchanged by this deletion.” (Office Action at 4.) Although, Applicants believe “chosen” satisfies all statutory requirements, Applicants have amended claims 14 and 25 per the Examiner’s suggestion. Applicants respectfully request the withdrawal of the rejection hereunder against claims 14 and 25, and earnestly solicit the timely issuance of a Notice of Allowance for these claims.

**V. Remarks Regarding New Matter.**

Claims 1-39 are rejected under 35 U.S.C. § 112, 1st Paragraph, and 35 U.S.C. § 132 because “the specification as originally filed does not provide support for the invention as is now claimed. The terms ‘from which hydrocarbons are removed’ are new matter.” (Office Action at 5.) Applicants have amended the relevant claims to delete the terms “from which hydrocarbons are removed” and have added the terms “penetrated by a well bore.” Support for this amendment may be found throughout the specification, *e.g.* paragraphs [0002], [0033], [0036], and [0037] of the Specification. Applicants respectfully request the withdrawal of the rejection hereunder against the present claims, and earnestly solicit the timely issuance of a Notice of Allowance for these claims.

**VI. Remarks Regarding Rejections of Claims 1-39 Under 35 U.S.C. § 102.**

The Examiner has rejected claims 1-39 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 6,087,418 to Yamashita et al. ("*Yamashita*"). With respect to this rejection the Office Action states:

Yamashita et al. teach a cement composition (which thus is used in a method to cement) comprising acrylic acid copolymers having an amino group in their molecules and their quaternized compounds (col. 17, lines 5-7). This quaternized compound is cationic and thus reads upon a cationic polymer. Further, Yamashita et al. '418 teach conventional additives to cement compositions include retarders such as phosphonic acids and their derivatives (col. 17, line 25), high early strength agents (ie accelerators or as applicants name them activators) such as KOH or NaOH (col. 17, lines 35-40) as well as alkanolamines, surfactants (same as surface active agents-see col. 18, lines 35-55), thickeners (same as viscosifiers-see col. 19, line 3), silica fume, fly ash, etc. Yamashita et al. further teach these additives may be added in plural (col. 19, line 9).

(Office Action at 6.) Applicants respectfully disagree.

In order to form a basis for a rejection under 35 U.S.C. § 102(b), a prior art reference must disclose each and every element as set forth in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004). *Yamashita* does not disclose each and every element as set forth in as-amended, independent claim 1 because *Yamashita* does not disclose a method of cementing comprising "permitting the cement composition to remain in a slurry state for a period of time prior to the cement composition being activated." Rather, *Yamashita* simply discloses that several additives, such as set retarders and "high-early-strength agents and promoters" may be added to the disclosed cement compositions. (*Yamashita*, col. 16, line 53 - col. 17, line 40.) In addition, *Yamashita* does not disclose a method of cementing comprising "placing the cement composition in a subterranean formation penetrated by a well bore." Thus, given that *Yamashita* does not teach all elements of claim 1, as amended, this reference cannot anticipate claim 1.

Consequently, for at least all the reasons stated above, Applicants respectfully submit that claim 1 is patentable over *Yamashita*. Moreover, since "a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers," and since claims 2-28 and 30-39 depend, either directly or indirectly, from claim 1, these dependent claims are allowable for at least the same reasons. See 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

**VII. Remarks Regarding Rejections of Claims 1-39 Under 35 U.S.C. §§ 102/103.**

The Examiner has rejected claims 1-39 under 35 U.S.C. § 102 (a) and (b) as anticipated by, or in the alternative, under 35 U.S.C. § 103 (a) as obvious over U.S. Patent No. 5,016,711 to Cowan ("*Cowan* '711"), U.S. Patent No. 5,275,654 to Cowan ("*Cowan* '654"), U.S. Patent No. 5,298,070 to Cowan ("*Cowan* '070"), U.S. Patent No. 6,402,832 to Vijayendran ("*Vijayendran*"), U.S. Patent No. 5,112,603 to Nadolsky et al. ("*Nadolsky*"), U.S. Patent No. 4,393,939 to Smith et al. ("*Smith*"), U.S. Patent No. 3,508,407 to Booth ("*Booth*"), CN 1385388 to Lu et al. ("*Lu*"), JP2000191350 to Tabori et al. ("*Tabori*"), JP 09020536 to Tamura et al. ("*Tamura*"), JP06128001 to Mizunuma et al. ("*Mizunuma*"), JP 05043293 to Koizumi ("*Koizumi*"), JP 61256956 to Yamaguchi et al. ("*Yamaguchi*"), or JP 59109663 to Takenaka Komuten Co. ("*Takenaka Co.*"), known collectively as the "Cited References," alone or in view of U.S. Patent No. 5,588,488 to Vijn et al. ("*Vijn*"), *Yamashita*, U.S. Patent No. 6,089,318 to Laramay et al. ("*Laramay*"), Scheetz et al. (abstract) ("*Scheetz*"), or U.S. Patent No. 4,131,480 to McCurrich ("*McCurrich*").

**A. The Cited References Do Not Anticipate or Obviate The Present Claims.**

Applicants respectfully submit that the Cited References do not disclose or suggest every element as recited in as-amended, independent claim 1 as required to anticipate the claims under 35 U.S.C. § 102(a) and (b), or to obviate the claims under 35 U.S.C. § 103(a). MPEP § 2131, 2142. In particular, the Cited References do not disclose or suggest a method of cementing comprising "permitting the cement composition to remain in a slurry state for a period of time prior to the cement composition being activated."

Applicants' Specification provides that it may be desirable to prepare a volume of a cement composition that is capable of remaining in a slurry state for a desired period of time. *See* Application, ¶ [0003] - [0006]. More specifically, Applicants' provide that the "settable fluids of the present invention are capable of remaining stable in a slurry state for several weeks or more before being activated by the addition of an activator composition." *See* Application, ¶ [0027]. Applicants respectfully assert that none of the Cited References disclose "permitting the cement composition to remain in a slurry state for a period of time prior to the cement composition being activated."

Furthermore, in addition to not teaching a method of cementing comprising "permitting the cement composition to remain in a slurry state for a period of time prior to the

cement composition being activated,” Applicants also submit that *Vijayendran, Nadolsky, Booth, Lu, Tobori, Tamura, Mizunuma, Koizumi, Yamaguchi, and Takenaka Co.* also do not teach “placing the cement composition in a subterranean formation penetrated by a well bore,” as recited by as-amended claim 1. Applicants respectfully submit that the present application is directed to subterranean formations penetrated by a well bore.

Because the Examiner has not shown that any of these references either in alone or in combination teach all limitations of claim 1, Applicants respectfully request that the rejection of claims 1 based upon these references be withdrawn, and respectfully request that this claim be allowed. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 2-28 and 30-39 depend, either directly or indirectly, from claim 1, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

**B. The Cited References In View Of *Vijn, Yamashita, Laramay, Scheetz, or McCurrich* Do Not Obviate Claims 1-39.**

The Cited References in view of *Vijn, Yamashita, Laramay, Scheetz, or McCurrich* do not obviate claims 1-28 and 30-39 of the present application. As discussed previously in Section VII.A., none of the Cited References teach a method of cementing comprising “permitting the cement composition to remain in a slurry state for a period of time prior to the cement composition being activated.” Nor can *Vijn, Yamashita, Laramay, Scheetz, or McCurrich* be used to supply this missing recitation. Accordingly, the Cited References in view of *Vijn, Yamashita, Laramay, Scheetz, or McCurrich* do not disclose or suggest every element of independent claim 1.

Therefore, independent claim 1 is not obviated by the Cited References in view of *Vijn, Yamashita, Laramay, Scheetz, or McCurrich*. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 2-28 and 30-39 depend, either directly or indirectly, from claim 1, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

### **VIII. No Waiver.**

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the Cited References. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art. The example distinctions discussed by Applicants are sufficient to overcome the anticipation and obviousness rejections.

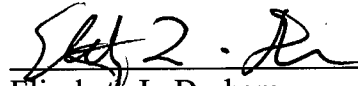
### **SUMMARY AND PETITION FOR TWO-MONTH EXTENSION OF TIME**

In light of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants' hereby petition under the provisions of 37 C.F.R. § 1.136(a) for a Two-Month Extension of Time to File this Response. Applicants authorize the Commissioner to debit Baker Botts L.L.P. Deposit Account No. 02-0383, Order Number 063718.0359, for the fee of \$450.00 under 37 C.F.R. 1.17(a)(2).

Applicants believe that there are no additional fees due in association with this filing of this Response. However, should the Commissioner deem that any fees are due, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.0359.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Elizabeth L. Durham", written over a horizontal line.

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